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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/782,546

**Applicant(s)**

LOGAN ET AL.

**Examiner**

ANDREW C. FLANDERS

**Art Unit**

2615

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-82 is/are pending in the application.
- 4a) Of the above claim(s) 63-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 5/19/08

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 34 - 62 drawn to an audio program player, classified in class 700, subclass 94.
- II. Claim 63 - 82, drawn to a host server, classified in class 709, subclass 238.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the host server could serve data to any particular type of computing device. The subcombination has separate utility such as an audio player.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if

any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Charles Gall on 16 September 2008 a provisional election was made without traverse to prosecute the invention of I, claims 34 - 62. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 63 – 82 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 19 May 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 34 – 62** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky (U.S. Patent 5,914,941) in view of Hair (U.S. Patent 5,966,440).

Regarding **Claim 34**, Janky discloses:

An audio program player (62) comprising:

an input port for receiving a plurality of separate digital compressed audio program files from an external source (input to data buffer 60, audio stored in the device is compressed; col. 5 lines 25 - 30);

a digital memory unit for persistently storing said audio program files (hard disk 50) and for further storing at least one sequencing file containing data specifying an

ordered sequence of a collection of said audio program files (the user can configure [and thus store a preference] the system such that an intelligent agent can be programmed to collate all such information for the user's review; col. 10 lines 30 – 35; additionally tags in the headers of transferred files are stored in the hard drive; col. 12 lines 30 – 35);

an audio output unit including at least one speaker or headset for reproducing said audio program files in audible form perceptible to a listener (headphone 56);

a processor for discontinuing the reproduction of the currently playing audio program file and instead continuing the reproduction at the beginning of a listener-selected one of said audio program files in said collection in response to a command from said listener (the microprocessor 66 controls storage and data retrieval functions; col. 9 lines 25 -35; Fig. 5 shows the audio playback mode of operation of the device, this device includes such commands as stop, fast forward, and fast rewind; col. 12 lines 53 – 59; these commands will allow a user to stop playing, start playing or control the playback however desired).

Janky does not explicitly disclose:

the processor is continuously delivering a succession of said audio program files in said collection to said audio output unit in said collection to said audio output unit in said ordered sequence specified by said sequencing file in the absence of a command from said listener.

However, Sequential playback of a plurality of audio files is notoriously well known in the art. Janky discloses a plurality of stored compressed audio files and the



ability to control their playback in any manner desired. Janky also discloses storing a configuration that allows the system to collate (i.e. sequence or order) a plurality of files.

In a related field of endeavor (i.e. audio storage and playback) Hair discloses:

A user selecting a plurality of files and the system sequentially reproducing the audio files; col. 2 lines 69 - 61). Applying this to the processor of Janky discloses:

the processor (66 of Janky )is continuously delivering a succession of said audio program files in said collection to said audio output unit in said collection to said audio output unit in said ordered sequence specified by said sequencing file in the absence of a command from said listener (the system reproduces the collate [i.e. ordered] files sequentially as taught by Hair).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the sequential playback technique of Hair to the collated files of Janky. One would have been motivated to do so to replay the collated files in Janky without user interaction. Additionally, sequential playback in audio system was so notoriously well known at the time of the invention it would have been obvious to try.

Regarding **Claim 35**, in addition to the elements stated above regarding claim 34, the combination further discloses:

a display screen for displaying a visible listing describing each audio program file in said collection (device contains a video display; col. 7 lines 1 – 5; the user may brows through each file by reading descriptions for the files in a display; col. 10 of Janky) wherein said listener selected audio program file is chosen by said listener by

employing one or more of said controls to select an audio program file described on said visible listing (using the controls to navigate through the files via a display; col. 11 lines 1 – 25 of Janky).

Regarding **Claim 36**, in addition to the elements stated above regarding claim 35, the combination further discloses:

wherein said display screen provides a visible indication of said currently playing audio program file on said visible listing (the display has the capability of visually indicating the current apparatus mode of operation as shown in claim 2 of Janky; during playback, this indicates the information of the file being played will be displayed).

Regarding **Claims 37 – 39**, in addition to the elements stated above regarding claim 36, the combination fails to explicitly disclose:

wherein said processor responds to a skip forward command, a single skip backward command, or two consecutive skip backward commands by discontinuing the reproduction of said currently playing audio program file and instead continuing the reproduction at the beginning of the audio program file which follows said currently audio program file in said ordered sequence by said sequencing file, the beginning of said currently playing audio program file or the program segment which precedes the currently playing program segment.

While these skip commands are not explicitly disclosed, Janky does disclose forward and backward commands. Modifying these commands to skip between the

plurality of files would have been notoriously well known in the art. The device stores a plurality of files and also has the ability to key forward, key backward, as well as pause, and individually select files using the user input commands. It would be desirable to allow a user to scroll back and forth through the plurality files via a skip command or to restart the current playback in order to allow a user to have greater freedom in audio file selection.

Regarding **Claim 40**, in addition to the elements stated above regarding claim 35, the combination further discloses:

wherein each of said audio program files stored in said digital memory unit is designated by a unique program identifier and wherein said sequencing file specifies the program identifier of each of the audio program files in said collection (the transferred files include identification tags by means of a header field which can be stored to the user's hard drive if desired; col. 12 lines 26 – 40 in Janky).

Regarding **Claim 41**, in addition to the elements stated above regarding claim 40, the combination further discloses:

wherein said digital memory further stores program description data comprising a plurality of program description records (i.e. identification tags; which can be stored; col. 12 lines 26 – 40 of Janky) each of which:

(a) describes a given one of said audio program files stored in said memory unit (inherent feature of identification tags),

(b) contains the unique program identifier designating said given one of said audio program files (identification tag is the unique identifier as shown in the rejection of claim 40, thus it contains the unique identifier by virtue of the fact it is unique to each program file),

(c) specifies displayable text describing said given one of said audio program files (information provides descriptions of the categories and titles in a display; col. 10).

The combination fails to explicitly disclose that the program description data:

(d) specifies the storage location of said given one of said audio program files.

However, it would have been obvious to provide this feature in order to allow the system to collate the files for the user's review as taught in col. 10. The system would need some way to identify the location of files that were to be collated for review in order to effectively produce the information in order (collated).

Regarding **Claim 42**, in addition to the elements stated above regarding claim 34, the combination further discloses:

a communications port for establishing a data communications link to one or more server computers for receiving said audio program files and said sequencing file from said one or more server computers (teleco modem 68; user sets up collation configuration, the files retrieved can thus be said to retrieve the "playback session" as the individual files are retrieved and set up in response to the collation configuration).

Regarding **Claim 43**, in addition to the elements stated above regarding claim 42, the combination further discloses:

wherein said audio program files received from said one or more server computers are selected by or on behalf of said listener from a library of audio program files available from said one or more server computers (i.e. library of program material 12 as part of the program distribution system).

Regarding **Claim 44**, in addition to the elements stated above regarding claim 43, the combination further discloses:

wherein at least some of said program files received from said one or more server computers are specified by requests transmitted by said listener to said server computer via said communication link (user makes a selection for a download of program material; col. 10 lines 35 – 50).

Regarding **Claim 45**, in addition to the elements stated above regarding claim 43, the combination further discloses:

wherein said one or more manual controls include a keyboard (keyboard col. 8 lines 1 – 5) for accepting account information from said listener that is transmitted via said communications link to said one or more server computers to establish a subscription account for said listener (i.e. subscriber and billing module; col. 8), said account information including a unique identification of said listener (inherent feature of a subscriber system), wherein at least some of said program files received from said

one or more server computers and specified by said requests transmitted by said listener are purchased by said listener and charged to said subscription account (i.e. the subscriber is billed for selected program materials by a fulfillment and billing method; col. 8).

The combination fails to explicitly disclose:

a password supplied by and known to said listener, and credit card information for use in billing charges to said listener.

However, passwords and using credit cards for paying for subscription services are notoriously well known in the art. Passwords are desirable to prevent unauthorized use and credit cards are desirable to provide for easy electronic payment. It would have been obvious to add these features to the Janky system for these reasons.

Regarding **Claim 46**, in addition to the elements stated above regarding claim 42, the combination further discloses:

wherein at least some of said program files received from said server computer are selected by or recommended by said server computer based on data describing the preferences of or past requests submitted by said listener files (the user can configure [and thus store a preference] the system such that an intelligent agent can be programmed to collate all such information for the user's review; col. 10 lines 30 – 35; additionally tags in the headers of transferred files are stored in the hard drive; col. 12 lines 30 – 35).

Regarding **Claim 47**, Janky discloses:

An audio program player for automatically playing a collection of audio program files selected by a listener (62), said player comprising, in combination:

a memory unit (50) for storing:

(a) a plurality of digital audio program files (audio stored in the device is compressed; col. 5 lines 25 - 30),

(b) program description data including displayable text describing each of said audio program files (the transferred files include identification tags by means of a header field which can be stored to the user's hard drive if desired; col. 12 lines 26 – 40 in Janky), and

(c) at least one playback session scheduling file which specifies an ordered sequence of a collection of said audio program files (the user can configure [and thus store a preference] the system such that an intelligent agent can be programmed to collate all such information for the user's review; col. 10 lines 30 – 35; additionally tags in the headers of transferred files are stored in the hard drive; col. 12 lines 30 – 35);

one or more controls for accepting input commands from said listener (such commands as stop, fast forward, and fast rewind; col. 12 lines 53 – 59),

a display screen for presenting a visual menu listing to said listener containing displayable text describing some or all of the audio program files in said collection

(device contains a video display; col. 7 lines 1 – 5; the user may brows through each file by reading descriptions for the files in a display; col. 10 of Janky),

a processor responsive to one of said input commands designating a selected audio program file described on said visual menu listing for causing said audio playback unit to discontinue the reproduction of the currently playing audio program file in said ordered sequence and to instead commence the reproduction of said selected audio program file (the microprocessor 66 controls storage and data retrieval functions; col. 9 lines 25 -35; Fig. 5 shows the audio playback mode of operation of the device, this device includes such commands as stop, fast forward, and fast rewind; col. 12 lines 53 – 59; these commands will allow a user to stop playing, start playing or control the playback however desired).

Janky does not explicitly disclose:

an audio playback unit for automatically and continuously reproducing said audio program files in said collection in the ordered sequence specified by said playback session scheduling file in the absence of a control command from said listener.

However, Sequential playback of a plurality of audio files is notoriously well known in the art. Janky discloses a plurality of stored compressed audio files and the ability to control their playback in any manner desired. Janky also discloses storing a configuration that allows the system to collate (i.e. sequence or order) a plurality of files.

In a related field of endeavor (i.e. audio storage and playback) Hair discloses:

A user selecting a plurality of files and the system sequentially reproducing the audio files; col. 2 lines 69 - 61). Applying this to the processor of Janky discloses:



an audio playback unit (the control logic of playback on the processor of Janky) for automatically and continuously reproducing said audio program files in said collection in the ordered sequence specified by said playback session scheduling file in the absence of a control command from said listener (the system reproduces the collate [i.e. ordered] files sequentially as taught by Hair).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the sequential playback technique of Hair to the collated files of Janky. One would have been motivated to do so to replay the collated files in Janky without user interaction. Additionally, sequential playback in audio system was so notoriously well known at the time of the invention it would have been obvious to try.

Regarding **Claim 48**, in addition to the elements stated above regarding claim 47, the combination further discloses:

wherein said display screen visually indicates the currently playing audio program file as playing progresses (the display has the capability of visually indicating the current apparatus mode of operation as shown in claim 2 of Janky; during playback, this indicates the information of the file being played will be displayed).

Regarding **Claim 49**, in addition to the elements stated above regarding claim 47, the combination further discloses:

a communications port for receiving said audio program files and said playback session scheduling file from said one or more server computers (teleco modem 68; user

sets up collation configuration, the files retrieved can thus be said to retrieve the “playback session” as the individual files are retrieved and set up in response to the collation configuration).

Regarding **Claim 50**, in addition to the elements stated above regarding claim 49, the combination further discloses:

wherein said audio program files received from said one or more server computers are selected by or on behalf of said listener from a library of audio program files available from said one or more server computers (user makes a selection for a download of program material; col. 10 lines 35 – 50).

Regarding **Claim 51**, in addition to the elements stated above regarding claim 50, the combination further discloses:

wherein at least some of said program files received from said one or more server computers are specified by requests transmitted to said server computer by said listener via said communications port (user makes a selection for a download of program material; col. 10 lines 35 – 50; files are transmitted over teleco modem 68 as shown in Fig. 1).

Regarding **Claim 52**, in addition to the elements stated above regarding claim 51, the combination further discloses:

at least some of said program files received from said server computer are purchased by said listener (program distribution system enables a subscriber to select desired programs and to be charged for the service; col. 8).

Regarding **Claim 53**, in addition to the elements stated above regarding claim 52, the combination further discloses:

wherein said one or more manual controls include a keyboard (keyboard col. 8 lines 1 – 5) for accepting account information from said listener that is transmitted via said communications link to said one or more server computers to establish a subscription account for said listener (i.e. subscriber and billing module; col. 8), said account information including a unique identification of said listener (inherent feature of a subscriber system), wherein at least some of said program files received from said one or more server computers and specified by said requests transmitted by said listener are purchased by said listener and charged to said subscription account (i.e. the subscriber is billed for selected program materials by a fulfillment and billing method; col. 8).

The combination fails to explicitly disclose:

a password supplied by and known to said listener, and credit card information for use in billing charges to said listener.

However, passwords and using credit cards for paying for subscription services are notoriously well known in the art. Passwords are desirable to prevent unauthorized

use and credit cards are desirable to provide for easy electronic payment. It would have been obvious to add these features to the Janky system for these reasons.

Regarding **Claim 54**, in addition to the elements stated above regarding claim 53, the combination further discloses:

wherein said audio program files purchased by said listener are transmitted to said player in encrypted form and wherein said processor decrypts said purchased audio program files prior to their reproduction by said audio playback unit (encryption/decryption key's in order to verify that the system is authorized to receive the programs ordered; col. 11 lines 40 – 45; algorithms to decrypt; col. 13 lines 1 - 10).

Regarding **Claim 55**, in addition to the elements stated above regarding claim 50 the combination further discloses:

wherein at least some of said program files received from said server computer are selected at said server computer based on data describing the preferences of said listener (the user can configure [and thus store a preference] the system such that an intelligent agent can be programmed to collate all such information for the user's review; col. 10 lines 30 – 35; thus when the system finds a match the server will send (i.e. select) the matched files).

Regarding **Claim 56**, in addition to the elements stated above regarding claim 50 the combination further discloses:

wherein at least some of said audio program files available from said one or more server computers are organized into subject matter categories (user can browse categories; col. 10) and wherein said player transmits a request to said one or more server computers for a catalog listing of programs available in a specified one of said categories and said player thereafter transmits a request for and receives one or more audio program files specified in said catalog listing of programs for future playback (user can schedule downloads based on information provided in the order/select mode; which displays the categories; col. 10).

Regarding **Claim 57**, in addition to the elements stated above regarding claim 50 the combination further discloses:

editing means operable by said listener for adding, deleting or reordering the audio program files specified by said playback session scheduling file (adding additional categories, which would add files to be collated; col. 10).

Regarding **Claims 58 – 60**, in addition to the elements stated above regarding claim 57, the combination fails to explicitly disclose:

wherein said processor responds to a skip forward command, a single skip backward command, or two consecutive skip backward commands by discontinuing the reproduction of said currently playing audio program file and instead continuing the reproduction at the beginning of the audio program file which follows said currently audio program file in said ordered sequence by said sequencing file, the beginning of

said currently playing audio program file or the program segment which precedes the currently playing program segment.

While these skip commands are not explicitly disclosed, Janky does disclose forward and backward commands. Modifying these commands to skip between the plurality of files would have been notoriously well known in the art. The device stores a plurality of files and also has the ability to key forward, key backward, as well as pause, and individually select files using the user input commands. It would be desirable to allow a user to scroll back and forth through the plurality files via a skip command or to restart the current playback in order to allow a user to have greater freedom in audio file selection.

Regarding **Claim 61**, in addition to the elements stated above regarding claim 47, the combination further discloses:

wherein each of said audio program files stored in said digital memory unit is designated by a unique program identifier and wherein said playback session scheduling file specifies the program identifier of each of the audio program files in said collection (the transferred files include identification tags by means of a header field which can be stored to the user's hard drive if desired; col. 12 lines 26 – 40 in Janky).

Regarding **Claim 62**, in addition to the elements stated above regarding claim 61, the combination further discloses:

wherein said program description data comprising a plurality of program description records (i.e. identification tags; which can be stored; col. 12 lines 26 – 40 of Janky) each of which:

(a) describes a given one of said audio program files stored in said memory unit (inherent feature of identification tags),

(b) contains the unique program identifier designating said given one of said audio program files (identification tag is the unique identifier as shown in the rejection of claim 40, thus it contains the unique identifier by virtue of the fact it is unique to each program file),

(c) specifies displayable text describing said given one of said audio program files (information provides descriptions of the categories and titles in a display; col. 10).

The combination fails to explicitly disclose that the program description data:

(d) specifies the storage location of said given one of said audio program files.

However, it would have been obvious to provide this feature in order to allow the system to collate the files for the user's review as taught in col. 10. The system would need some way to identify the location of files that were to be collated for review in order to effectively produce the information in order (collated).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 34 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,199,076. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '076 patent anticipates all limitations of claims 34 and 47 of the instant application except the audio output unit including at least one speaker or headset for reproducing said audio program files in audible form perceptible to a user. However, Claim1 of the '076 patent claims reproducing audio program, reproduction of an audio program requires some sort of speaker or headset. It would have been obvious to one of ordinary skill in the art to apply the claimed audio output unit of the instant application to claim 1 of the '076 patent for the purpose of reproducing the audio program.

Claims 35, 36, 47 and 48 are rejected for the same grounds as stated above regarding claim 34. In addition, the '076 patent doesn't explicit disclose a display for displaying information and menu controls. However, it was notoriously well known in



the art at the time of the invention to include these features. Simple LCD screens and menus were notoriously well known to be included on portable music players such as CD players for the purpose of making the use of the device easier by way of showing the time of the track, and other options of the device via menus.

Claims 37 – 39 are anticipated by claims 1 – 3 of the '076 patent.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW C. FLANDERS whose telephone number is (571)272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suhan Ni can be reached on (571) 272-7505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Andrew C Flanders/  
Patent Examiner  
Art Unit 2615